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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/636,571      | 08/10/2000  | Kazuhiko Nakamura    | D01-4120/TK         | 6450             |

26689 7590 10/15/2002

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EXAMINER

SHORT, PATRICIA A

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TC-12

**Office Action Summary**

|                 |           |                |                |
|-----------------|-----------|----------------|----------------|
| Application No. | 09/636571 | Applicant(s)   | Nakamura et al |
| Examiner        | Short     | Group Art Unit | 1712           |

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

Responsive to communication(s) filed on August 7, 2002

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

Claim(s) 1-54 is/are pending in the application.

Of the above claim(s) 51-54 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-50 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

**Application Papers**

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119 (a)-(d)**

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

All  Some\*  None of the:

Certified copies of the priority documents have been received.

Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

**Attachment(s)**

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

**Office Action Summary**

Art Unit: 1712

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear what is meant by the language "substantially no acid anhydride group" and "until an acid anhydride group is substantially completely vanished". Applicant relies upon page 73, lines 10-13 of the specification where it is disclosed that the area ratio represented by the acid anhydride group (1,783 to 1,822 cm<sup>-1</sup>)/benzene ring (683 to 721 cm<sup>-1</sup>) is 0.03 or less. Does this language mean that the area ratio represented by the acid anhydride group (1,783 to 1,822 cm<sup>-1</sup>)/benzene ring (683 to 721 cm<sup>-1</sup>) is 0.03 or less? If not, then what does the language mean? As the language "substantially no acid anhydride group" and "until an acid anhydride group is substantially completely vanished", is not defined in the specification, it is not clear when the claims would be infringed. Additionally, claim 1 is indefinite in the use of the word "pan" in line 3 and "anti" in line 4. In claims 11 and 35, the language "obtainable" is indefinite as it is not clear what is required other than a stable or hardenable polymer.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scheve. The rejection is applied as in the previous Office action. The reference mixes the alcohol (HPMA) with the acrylate copolymer under conditions in which it would inherently react with the acid anhydride produced as a side reaction when the isocyanate compound reacts with the acid groups of the acrylate copolymer. See the instant specification at page 42, penultimate line through page 43, line 11. As it is not clear what is meant by "substantially no acid anhydride group" and "until an acid anhydride group is substantially completely vanished", it is not clear that the claims distinguish over the hardenable polymer of the reference. Additionally, it is not clear that claims 11 and 35 require reaction "until an acid anhydride group is substantially completely vanished". Finally, claims 42-50 are not limited to methods in which the alcohol is reacted "until an acid anhydride group is substantially completely vanished".

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

P. Short

October 8, 2002

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PATRICIA A. SHORT  
PRIMARY EXAMINER

*Patricia Short*